



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,971	04/13/2000	Sarah Liljegren	19452A-000700US	7002
7590 08/06/2004 Townsend and Townsend and Crew LLP Two Embarcadero Center 8th Fl San Francisco, CA 94111-3834			EXAMINER KRUSE, DAVID H	
			ART UNIT 1638	PAPER NUMBER

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

**Application No.**

09/548,971

**Applicant(s)**

LILJEGREN ET AL.

**Examiner**

David H Kruse

**Art Unit**

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5,7,9-11,13-18,20-28,30,34 and 36-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,7,9-11,13-18,20-28,30 and 41 is/are allowed.
- 6) ☒ Claim(s) 34,36-40 and 42-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **STATUS OF THE APPLICATION**

1. This Office action is in response to the Amendment and Remarks filed 19 May 2004.
2. The Examiner acknowledges Applicant's summary of the interview conducted on 25 February 2004 on page 8 of the response.
3. Claims 5, 7, 9-11, 13-18, 20-28, 30 and 41 are allowed.
4. Those rejections not specifically addressed in this Office action are withdrawn in view of Applicant's amendments to the claims.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Specification***

6. The disclosure is objected to because of the following informalities: The Examiner notes that parent application 09/339,998 has issued as U.S. Patent 6,410,826. The first line of the specification must now be amended to reflect this fact.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. Claims 34 and 36-40 remain rejected and claims 42-57 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is repeated for the reason of record as set forth in the last

Office action mailed 18 November 2003. Applicant's arguments filed 19 May 2004 have been fully considered but they are not persuasive.

The Examiner finds that the instant application does not provide adequate written description support for the limitation "comprises at least 200 contiguous nucleotides from positions 2765 to 3361 of SEQ ID NO: 1". In addition the limitation "comprises at least 500 contiguous nucleotides from positions 2765 to 3361 of SEQ ID NO: 1" at claims 36 and 45 does not have adequate written description support in the instant application. This is a New Matter rejection.

Applicant argues that support for this limitation is found throughout the specification, for example at page 3, lines 28-29, at page 9, lines 12-19 and at page 14, lines 1-5 (page 8, 3<sup>rd</sup> paragraph of the Remarks). This argument is not found to be persuasive because the Examiner can find no support on page 3, lines 28-29 or on page 14, lines 1-5 of the specification. On page 9, lines 12-19 of the specification applicant describes nucleic acid sequences that hybridize to SEQ ID NO: 1, and does not describe 200 contiguous nucleotides from positions 2765 to 3361 of SEQ ID NO: 1 as claimed. In addition, there is no written description support for 500 contiguous nucleotides in the specification. The issue of New Matter remains.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1638

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Claims 34 and 36-40 remain rejected and claims 42-57 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (571) 272-0804. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-0547.



DAVID H. KRUSE, PH.D.  
PATENT EXAMINER

*Art 1638*

David H. Kruse, Ph.D.  
4 August 2004

Art Unit: 1638

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.